UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,384	11/03/2003	Nebojsa Curcic	FA1169USNA	5811

23906 7590 10/26/2005

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER	
CAMERON, ERMA C	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/700,384	CURCIC ET AL.	
	Examiner	Art Unit	
	Erma Cameron	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5,7 and 8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5,7 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Election/Restrictions

1. Claims 3-4, 6 and 9 are canceled as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/22/2005. The applicant has clearly admitted on the record that the species of claim 1 are obvious variants.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The rejection of Claim 8 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 5 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rattee et al (4315790).

'790 teaches applying a composition to a fabric, the composition being comprised of a dye or pigment, a film-forming polymer, a crosslinking agent and a catalyst (see Abstract; 3:55-4:15). The composition is applied to a supporting substrate by screen printing (see Examples). The layer of transferable composition material on a substrate is pressed to the fabric while heating (an example of contact heating), and in one embodiment, the heating effects curing of the composition before removal of the substrate (6:65-7:11). The polymers include acrylics and others that would be polymerizable by free-radicals (5:41-68). The application of the coating may be considered original coating or decoration with an image.

The applicant has argued in the 9/22/2005 amendment that the substrates of claims 1 and 7 are not fabrics. However, the claims do not state this. It is the examiner's position that the plastic of claim 1 could be a fabric (for instance, any number of synthetic fibers), as could the glass of claim 1 (as a fiberglass fabric). The body parts or body fittings of claim 7 could also be fabrics, such as fabric on a vehicle interior. The applicant has also argued that the ink used in the screen printing process of '790 is not a coating used by applicant. However, the claims do not

state this. The claims only state that the composition being applied to the baking foil by screen printing is a curable coating composition.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rattee et al (4315790).

'790 is applied here for the reasons given above.

'790 does not teach that the composition is applied to a vehicle body, or body part or body fitting, but the fabric of '790 could be part of an automobile, such as fabric to be used in seats. The body parts or body fittings of claim 7 could also be fabrics, such as fabric on a vehicle interior.

8. Claims 1-2, 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over George (4061516) taken in view of Vogels et al (US 2002/0022575) or Rattee et al (4315790).

'516 teaches applying a design, thermoplastic base coat (an acrylic) and an adhesive (another acrylic) to a carrier sheet such as Mylar, and adhering the coating material to a substrate thru heat and pressure from a roller (i.e. contact heating), after which the Mylar sheet is stripped off (1:55-3:15).

'516 does not state that the coating materials are cured before application to the substrate, therefore, they are expected to be uncured state. The acrylics are olefinic double bonded materials that cure with free-radicals.

Regarding the substrate, the substrate of '516 may be an automotive part or fitting.

'516 does not teach screen printing the coating composition onto the backing foil.

'575 teaches that screen printing may be used to apply curable acrylic layers to support layers (see Abstract). '790 also teaches that screen printing may be used to apply curable layers to a support layer (see Examples).

It would have been obvious to one of ordinary skill in the art to have used the '575 screen printing technique or the '790 screen printing technique in the '516 process, because both teach that screen printing is a conventional method of applying a curable material to a support layer.

The applicant has argued in the 9/22/2005 amendment that the amended claims do not cover the multiple layers of '516. However, the open "comprising" language of claim 1 allows for multiple layers. The applicant has also argued that '575 has nothing to do with the use of backing foils. However, '575 is used here to teach that screen printing may be used to apply a curable composition to a support layer.

9. The rejection of Claims 1-2, 5 and 7-8 under 35 U.S.C. 103(a) as being unpatentable over WO 95/02461 taken in view of Vogels et al (US2002/0011575) or Rattee et al (4315790) is withdrawn because of the amendment filed 9/22/2005.

Double Patenting

10. Terminal disclaimers for 10/017132 and 10/611731 have been received and approved.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1, 5 and 7-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 9, 13, 17, 21, 25, 29 and 33 of U.S. Patent No. 6933006. Although the conflicting claims are not identical, they are not patentably distinct from each other because the processes of the instant claims and of 6933006 are similar except that the instant claims claim the application of the curable composition to the backing foil by screen printing, whereas '006 is silent as to the application method.

13. The rejection of Claims 1-2, 5 and 7-8 under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/017132 which has a common assignee with the instant application is withdrawn because of the amendment filed 9/22/2005.

14. The rejection of Claims 1-2, 5 and 7-8 under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/611731 which has a common inventor and assignee with the instant application, is withdrawn because of the amendment filed 9/22/2005.

15. Claims 1, 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being obvious over Fey et al (6933006).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in

accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

'006 teaches using a backing foil to apply a coating to a substrate, and then curing it with irradiation. The substrate may be automotive bodies and the coating is free-radical polymerizable (see Abstract and claims). '006 does not teach that the coating is applied to the backing foil by screen printing, but it would have been conventional to apply a coating by this method.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Erma Cameron
ERMA CAMERON
PRIMARY EXAMINER

Erma Cameron
Primary Examiner
Art Unit 1762

October 24, 2005